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DEC 16 2010

*In the United States Patent and Trademark Office*

Appn. Number: 09/641,410  
Appn. Filed: August 18, 2000  
Applicant: Alice Mary O'Donnell Kiely  
Title: Edible Supports for Comestibles with Optional, Edible Mess Guards and  
Drip Guards  
Examiner/GAU: Keith Hendricks/Joyti Chawla 1794

Yorktown Heights, NY December 16, 2010

**RENEWED PETITION TO THE OFFICE OF PETITIONS****Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181(a)**

Assistant Commissioner for Patents  
Arlington, Virginia 22313

Sir:

Applicant respectfully requests reconsideration and withdrawal of the holding of abandonment for above application 09/641,410, Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards, as the final Office Action is respectfully submitted to have been premature.

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Appn. Number 09/641,410 (Kiely) GAU 1794 Renewed Petition to Withdraw the Holding of Abandonment 2**Request for Withdrawal of the Holding of Abandonment**

This correspondence is in regard to U.S. Patent Application SR Number 09/641,410, Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards. Application 09/641,410 is a parent application to several divisional applications. Patent Application SR No. 09/641,410 was filed August 18, 2000, and is currently pending.

Claims 383 - 416 are pending in the current application. Claims 403 - 416 are withdrawn from consideration as said to be directed to a non-elected invention.

Applicant had sent a petition to the Director of Patents for the Withdrawal of the Holding of Abandonment under 37 CFR 1.181(a) for the above application on March 27, 2010, as Applicant respectfully submits that the Final Office action was premature and therefore improper. This petition has been denied. Applicant sent an appeal on September 10, 2010. Applicant is now in receipt of a recent decision regarding the this petition. The appeal was also denied. The entire content of this first petition can be seen in the entry of 3/29/2010, 51 pages.

Applicant respectfully requests reconsideration and withdrawal of the finality of the Office Action as it is respectfully submitted to have been premature.

In support of this request, Applicant states the following:

**Regarding Election/Restriction:**

The Final Office action of July 9, 2009 stated:

Newly submitted claims 403-416 are directed to a method of making a support, i.e., an invention that is independent or distinct from the invention elected in response filed January 18, 2003 to the original restriction requirement.

Since applicant had elected a product and not the method of making in response to

the election requirement the method of making the product, i.e., claims 403-416 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP section 821.03. Thus claims 403-416 will not be examined in the present office action.

**Thus, claims 383-402 directed to the product, i.e., elected invention, will be examined in the present application. (Page 2)**

Applicant's amendment necessitated the new grounds of rejection presented in the Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP section 706.07(a). (Conclusion)

A similar rejection had been made in the Non-final Office Action on 10/16/08. (**Exhibit C**)

To the contrary, Applicant's restriction requirement on December 19, 2002 was to elect a SPECIES. The restriction stated:

Applicant is required under 35 USC 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any subsequently added. (**Exhibit A**, last two paragraphs)

Applicant elected SPECIES III in response to the choices of species given, i.e. Species I, Species II, Species III, or Species IV. (**Exhibit B**, first paragraph)

On 1/16/2009 Applicant response to the restriction stated:

As of now, Examiner has not related to applicant how the method claim as filed in the RCE is patenably distinct from the generic claim. As far as applicant is aware,

method claims 345-348 includes all of the limitations of the generic claim. (**Exhibit D**, Response to NFOA)

Where an application contains claims to a product, claims for a process specially adapted for (i.e. not patentably distinct from) as defined in MPEP section 806.05(f) making the product, and claims to a process of using a product, applicant may be required to elect either (A) the product and process of making it; or (B) the process of using. If the examiner cannot make a showing of distinctness, between the process of using and the product (please see MPEP section 806.05(h)), restriction cannot be required. (806.05 (i) Product, Process of Making, and Process of Using) (37 CFR 1.141)

Applicant respectfully submits that the final Rejection was premature as Examiner did not state any reason whatsoever of how Applicant's claims 403-416 are distinct and directed to a non-elected invention, the burden of Examiner, as required, MPEP 806.05(f) Process of Making and Product Made; MPEP 808.01, below, and did not answer Applicant when Applicant asked for the reason for distinction. The Office neither took "note of" Applicant's argument nor "answered the substance of" Applicant's argument. Thus the final Office Action is deficient because the Office failed to satisfy the requirements of MPEP section 707.07(f).

Applicant respectfully submits that the Final Rejection was premature as Examiner also did not consider or respond to Applicant's argument a) that Applicant had elected a species which did not preclude Applicant from a method claim(s), b) that all of Applicant's claims were directed to the same invention, and c) no restriction between a product and a method had ever been made. (**Exhibit D**, Response to NFOA, first six paragraphs) (**Exhibit F**, response to Final) Examiner merely repeated in the Final Rejection that claims 403-416 remained withheld. (**Exhibit E**, Final OA, Election/ Restriction) Applicant continued to request withdrawal of the finality of the Office Action. (**Exhibit G**, response after final, entire page)

Applicant respectfully submits that in the absence of such a reason, or example, of independent inventions or distinct inventions, or a specific example or reason why it would be a burden on

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examiner if restriction is not required, as above, that the withdrawal of Applicant's claims 403-416 from consideration was clearly improper.

#### 808.01 Reasons for Holding of Independence or Distinctness

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

#### MPEP 803 Restriction When Proper

##### II Guidelines

Examiner must provide reasons or examples of conclusions but need not cite documents to support the requirement in most cases.

##### CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) the inventions must be independent (see MPEP section 802.01, section 806.06, 808.01) or distinct as claimed (see MPEP section 806.05 - 806.05(j) and

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP section 803.02, section 808, and section 808.02)

#### Regarding Amendments to Specification:

The final Office Action on page 3 stated:

The amendment filed March 16, 2009, is once again objected to under 35 USC 132(a) because it introduces new matter into the disclosure. ... the term "a composite material" as disclosed in the amendment would introduce new matter and change the description from "a candy bar" to "composite material candy bar" in paragraph [0164] which is not the same as a generic term "candy bar" as originally described. Therefore the amendments to the specification introduce new matter and the applicant is required to cancel the new matter in the reply to this Office action.

In response, Applicant for years has given evidence that the term "composite material" is not new matter as "composite material" is recited in original claims 6, 19, 21-23, on 8/18/2000. (MPEP 608.01[(I)] Original Claims). Examiner continues to fail to consider Applicant's evidence. (Exhibit H, response to NFOA, page 2, first paragraph) Examiner's solution is to disregard Applicant's argument and repeat the rejection. Applicant respectfully submits that the finality of the Office Action is premature for the additional reason that Examiner failed to consider or respond to Applicant's argument that the term "composite material" is not "new matter" as it is recited in original claims 6, 19, 21-23, as originally filed.

**Regarding 35 USC Section 112 (first paragraph):**

The Final Office Action states:

In the instant case the term "composite material" as added to the claims introduce new matter as the term is not disclosed in the original disclosure and the introduction of the term "composite material" as added to the claims introduces new matter as the term is not disclosed in the original disclosure and the introduction of the term "composite material" changes the description of "a candy bar" to "a composite material candy bar" which is not the same as a generic term "candy" as originally described.

Applicant respectfully submits that the finality of the Office Action is premature for the additional reason that Examiner has failed to consider or respond to Applicant's argument that the term "composite material" is not "new matter" as it is recited in original claims 6, 19, 21-23. (Exhibit I, response to NFOA, 1 page)

**Regarding 35 USC Section 112 (second paragraph):**

The Final Office Action states:

Claims are indefinite for the recitation of "composite material." Applicant has not

distinguished between the terms in the specification and thus the claim as recited is unclear as to what is the scope of the term composite material. It is unclear whether the claim requires material that can form a composite or materials that are composites themselves or some other. The term "composite" recited is indefinite as it is unclear as to what the term composite refers to because even if a small part of edible support comprises a composite, then the entire support would be considered as a composite..."

Applicant respectfully submits that the finality of the Office Action is premature for the additional reason that Examiner failed to consider or respond to Applicant's argument that the term "composite material" is a well known term in commerce, which Applicant is not required to teach and/or use and that the term "composite material" is not "unclear" as it is well known since ancient times and is a well known term used in commerce at least since 1912. (Exhibit J, response to NFOA, 1 page)

**Regarding 35 USC Section 102:**

The Office Action states:

Regarding claims 383-394, Musher (US 2,217,700) teaches ice cream (frozen comestible) on a non-frozen edible support structure or a composite support which has at least two edible discernable (i.e. perceptible) edible confectionary materials or components that are combined together to make the support, i.e., two constituent ingredient materials... as instantly claimed.

**Regarding Claim Interpretation:**

Applicant respectfully submits that the finality of the Office Action is premature as the Office has taken an improper and unreasonable interpretation of the claim terms and for this additional reason. The Office has misinterpreted the claims to read a "composite support," when Examiner(s) are well aware that Applicant had disclosed a support comprising an edible

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“composite” or “composite material.” (Exhibit K, non-final Office Action, first Office Action on the merits, 5/23/2003, “*since the edible support is disclosed as being a composite...*”)

**Regarding: State when Claims are Allowable:**

A) Applicant respectfully submits that the finality of the Office Action is premature as while Examiner agrees that the support of Musher is entirely frozen, (Exhibit L - Final OA, 4/30/08, bottom/top of pages 18 and 19 respectively) and thus Applicant’s claims are in fact not anticipated under section 102, Examiner has failed to state when claims are allowable. Thus the finality of the Office Action is respectfully submitted to be premature for this additional reason.

B) While Examiner agrees with the definition of “composite material” in the Merriam Webster Dictionary (Exhibit M, child/divisional application 11/903,722, 4/1/10, pgs. 8 and 9 of OA; page 32 of Applicant’s response 6/24/10, in view of “composite material” and reference to Musher) which defines that a “composite material is a “solid material,” and thus Applicant’s claims are in fact not anticipated under section 102, (Musher’s unit structure is undeniably replete with holes) Examiner has failed to state when claims are allowable. Thus the finality of the Office Action is respectfully submitted to be premature for this additional reason.

C) Applicant’s argument of how the structure of Feybusch (US 1,638,4880) does not anticipate Applicant’s claims since it is not a solid or a composite material, as it at least requires crevices to drain melting ice cream away from a user’s hand when it is being eaten, had not been noted or answered. (MPEP 707.07(f) Answer all Material Traversed) (response to NFOA 3/16/09, page 18, para. 5) i.e. no response to Applicant’s argument) Thus the finality of the Office Action is respectfully submitted to be premature for this additional reason.

**Regarding New Reference in Final Office Action not Necessitated by Amendment or IDS:**



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The final Office Action stated that A) Claim 391 is rejected under 35 USC section 103(a) as being unpatentable over Feybusch (US 1,638,480) in view of Lane et al. (1,690,984) hereinafter Lane.

The Office introduced a new reference to Lane in the Final Office Action. **(Exhibit N)** This new introduction to Lane was “neither necessitated by Applicant’s amendment of the claims, nor based on information submitted in a an information disclosure statement filed during the period set for the in 37 CFR 1.997(c) with the fee set forth in 37 CFR 1.17(p).” (MPEP 706.07(a))

Section 706.07(a) of the MPEP specifies the conditions under which the finality of a second or subsequent Office Action is proper, providing that:

“Furthermore a second or subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection on newly recited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) of any claim not amended by applicant or patent owner in spite of the fact that other claims might have been amended to require newly required art.”

Applicant’s claim of an “edible hollow confection length” was already on file as of at least 7/30/2008. Examiner was able to present the reference to Lane et al. in the Non-final Office Action of 10/16/2008, but chose not to. Thus, Examiner’s introduction of the brand new reference to Lane in the Final Office Action, not previously of the record, precludes the Office Action from being final. Thus the finality of the Office Action is premature for this additional reason.

Applicant respectfully submits that even one of the above examples is ground for the withdrawal of the holding of abandonment. Applicant respectfully submits that the final Office Action was clearly premature and therefore improper.

**Conclusion:**

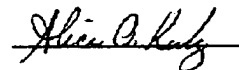
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In view of the foregoing, Applicants respectfully requests withdrawal of the finality of the Office Action of 7/9/2009, and thus the withdrawal of the holding of abandonment for the above application. Applicant also respectfully requests that Applicant's claims 403 - 416 be considered along with the remaining claims, and that a new non-final Office Action be sent to Applicant.

Applicant is most appreciative of the Office's kind consideration.

Very Respectfully,



Alice O. Kiely

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Yorktown Heights, NY 10598

Tel. (914) 960-3506

Certificate of Facsimile: I certify that on the date below, this document and referenced attachments, if any, will be faxed to the central fax number of 571-273-8300 to the United States Patent and Trademark Office "Commissioner for Patents" Arlington, Virginia 22313.

2010 December 16,



Alice O. Kiely

Attachments:

Exhibits A through N

Exhibit A • Restriction •

12/19/02 pg 1/1

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Page 2

Art Unit: 1714

For the record, applicant has not specifically addressed the election of species set forth in the Office action mailed 5/2/02, paper no. 7. Ordinarily, applicant is required to elect one or more species. There is no statement that an election was not made since the amendment presents a group of claims to which the election is no longer relevant. However, this does seem to be the case.

In view of the presentation of the new set of claims in the amendment filed 6/5/02, paper no. 8, the election in paper no. 7 is withdrawn in favor of the following new election:

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I, wherein the comestible has a support as shown e.g. in Fig 1, or

Species II, wherein the comestible has a plurality of supports as shown e.g. in Fig 35-39,

and

Further, election is also required between

Species III, wherein the support is a composite support, as shown e.g. in Fig 1, or

Species IV, wherein the support is a homogeneous support as shown e.g. in Fig 3

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Exhibit B

Response to Restriction  
Requirement

1/18/03

Pg. 1/1

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(Kiely)

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Amnt. B, contd.

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By the above amendment, Applicant has addressed and elected the single disclosed Species III, above, as required under 35 U.S.C. 121, of "a composite support," and a listing of all new claims (72-98) readable thereon, also above.

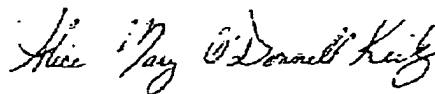
Applicant has amended the claims of the above application to elect a single patentable species.

No new matter has been entered by way of amending the claims.

#### Conclusion

For the above reasons, applicant submits that the claims are now in proper form, and that the claims all define a patentable invention. Therefore she submits that this application is now in condition for allowance, which action she respectfully solicits.

Very Respectfully,



Alice Mary O'Donnell Kiely

Exhibit C Non Final Office Action 10/16/08

pg. 1/2

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**DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 30, 2008 has been entered. Claims 1-348 have been cancelled and claims 349-382 have been added.

**Note:** To expedite prosecution applicant is requested to furnish support for the subject matter recited in the new and amended claims in the current application. Furthermore, the applicant is requested to recite the claims such that the rejections made under 35 USC 112 in the previous office actions are corrected.

**Election/Restrictions**

Newly submitted claims 370-382 are directed to a method of making a support, i.e., an invention that is independent or distinct from the invention elected in response filed January 18, 2003 to the original restriction requirement.

Since applicant had elected a product and not the method of making in response to the election requirement the method of making the product, i.e., claims 370-382 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Thus claims 345-348 will not be examined in the present office action.

Thus claims 349-369 will be examined in the present application.

**Amendments to Specification**

The amendment filed July 30, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment

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Exhibit C Non Final Office Action 10/16/08

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filed July 30, 2008 are addressed to the new claims and thus are moot in view of the new grounds of rejection.

I) Regarding the support for the terms rejected under 35 U.S.C. 112, applicant has presented no comments and although the applicant has removed the rejected claims, the newly added claims continue to be unclear for the reasons of record. For expediting the prosecution in future, the applicant is requested to provide support in the original disclosure of the present application for future reference.

II) Applicant's remarks regarding Musher have been fully considered but have been responded in the previous office action dated April 30, 2008 not been found persuasive.

Applicant's claim for new and unexpected results has been considered however applicant's remarks have materials and ingredients that have not been claimed as such and the applicant also claims of obtaining unique results by using commonly known and used components. Further the remarks offer no new data or experimentation that provides any evidence of the unexpected results. Thus applicant's remarks are not persuasive and claims 249-269 are rejected for reasons of record.

Thus applicant's remarks have been fully considered but have not been found persuasive and claims 319-344 have been rejected for reasons of record.

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

JAN-16-2009 07:06P FROM: DANIEL KIELY 9142456661

TD:15712738300

P:21/23

**Exhibit D** *Response to Non Final Office Action* 1/16/09  
Appn. Number 09/641,410 (Kiely) GAD 1794 Amendment A 20

present office action.

In response: The restriction requirement for which a response was made on January 18, 2003 was for the following:

Species I, wherein the comestible has a support as shown e.g. in Fig 1, or  
Species II, wherein the comestible has a plurality of supports as shown e.g. in Gif. 35-39  
Further election is also required between  
Species III, wherein the support is a composite support, as shown e.g. in Fig. 1, or  
Species IV wherein the support is a homogenous support as shown e.g. in Fig. 3

Applicant elected Species III, "composite support." As may be seen above, there was no requirement for restriction of any method claim by an Examiner.

The requirement for restriction of 5/02/2002 also did not require any restriction regarding a method claim. In addition, all previous claims for the above application had been canceled. All present claims (after RCE) are directed to the same invention as elected in species III, as allowed.

37 CFR 1.142 entitles applicant to claim additional species that includes the limitations of a generic claim. As of now, Examiner has not related to applicant how the method claim as filed in the RCE is patentably distinct from the generic claim. As far as applicant is aware, method claims 345-348 includes all of the limitations of the generic claim.

There is no legal justification for the Election/Restriction objection and the premise that, "Thus claims 345-348 (370-382) will not be examined in the present office action." Withdrawing Applicant's claims from consideration is delay of prosecution and prejudicial. Applicant respectfully requests removal of the objection and examination/reinstatement of all pending claims 349-383 for the above claims, as written.

#### Claim Rejections - 35 USC section 112 (first paragraph)

The examiner states that claims 368 and 369 are rejected under 35 USC 112, first paragraph as failing to comply with the enablement requirement. In the instant case claim 368 as recited is non enabled as there is no disclosure either in the claim or in the specification about what means or

PAGE 21/23 \* RCVD AT 1/16/2009 6:59:30 PM [Eastern Standard Time] \* SVR:USPTO-EFXXF-6/39 \* DNIS:2738300 \* CSID:9142456661 \* DURATION (mm:ss):07-08

*Exhibit E Final Rejection 7/9/09*Application/Control Number: 09/641,410  
Art Unit: 1794

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**DETAILED ACTION**

Applicant's submission filed on March 16, 2009 has been entered as compliant. Previously examined claims 1-382 have been cancelled, and all new claims 383-416 are added to the current application. Claims 383-416 are pending and examined in the current application.

**Note:** To expedite prosecution applicant is requested to furnish support for the subject matter recited in the new and amended claims in the current application. Furthermore, the applicant is requested to recite the claims such that the rejections made under 35 USC 112 in the previous office actions are corrected.

***Election/Restrictions***

Newly submitted claims 403-416 are directed to a method of making a support, i.e., an invention that is independent or distinct from the invention elected in response filed January 18, 2003 to the original restriction requirement.

Since applicant had elected a product and not the method of making in response to the election requirement the method of making the product, i.e., claims 403-416 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Thus claims 403-416 will not be examined in the present office action.

**Thus, claims 383- 402 directed to the product, i.e., elected invention, will be examined in the present application.**

***Amendments to Specification***

The amendment filed March 16, 2009, is once again objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added



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Alice Kiely

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p.16

Exhibit F

Response to Final Rejection

10/9/2009

App. Number 09/641,410 (Kiely)

GAU 1794

Response to Office Action

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## Remarks General

## Regarding Election/Restriction:

Claims 403-416 are said to be rejected as being independent or distinct from the invention elected in response filed January 18, 2003.

The record shows that NO restriction of a product vs. method had been required in any Office Action for the above application. As far as Applicant is aware, choosing a species does not preclude one from including a method claim(s) if it is not independent or distinct from the elected species. See for example: 35 USC Section 101; 35 USC Section 112(6). As for the present instant rejection, Examiner has made no attempt to say how these claims are independent or distinct from Applicant's "examined" claims, as required, and therefore the rejection is improper for at least this reason.

Applicant cannot properly respond to this allegation. (MPEP ' 706.07(a)  
Examiner's restriction is improper. MPEP 808.02. Applicant therefore respectfully requests withdrawal of the objection and reconsideration and allowance of the method claims.

## Regarding Amendments to Specification:

The proposed amendments to the specification have been objected to under 35 USC 132(a) as said to introduce new matter into the disclosure. The added material which is said to not be supported by the original disclosure is as follows: the addition of "composite material" which is said to change the description from "a candy bar" to "a composite material candy bar" which is not the same as a generic term "candy bar" as originally described.

Applicant respectfully disagrees that the terminology "composite material" in the requested amendment is new matter. The term "composite material" is disclosed in original claims 6, 19-23,

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Nov 22 09 05:52p

Alice Kiely

914 245-6661

p.16

Exhibit G Response after Final

11/23/09

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Response to Office Action

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## Remarks General

Applicant respectfully requests withdrawal of the finality of the Office Action, since it is noted to be improper.

**The Finality of the Office Action is Improper**

Examiner expects to impose unjustified rejections *without any factual evidence*.

Examiner has also introduced a new reference to Lane US 1,690,984) and hence the finality of the Office Action is improper.

It is of the record that examiner has at least:

- 1). Not made a prima facie case of a "non-elected invention" (burden of examiner ) i.e. has not articulated an alternative method to Applicant's method claims 403-416 as being patentably distinct (see MPEP § 707.07(f)).
- 2). Not made a prima facie case of new matter for amendments to specification (burden of examiner) when Applicant had claimed "a composite material," as originally filed in claims 6, 19, 20, 21, 22, and 23, or enablement with regard to page 2: 35 USC 132(a) and 35 USC section 112, first paragraph, other than a generic MPEP paragraph stated rejection, which is not a sufficient or a valid reason (see 35 USC 132(a)).
- 4). Not made a prima facie case of anticipation (burden of examiner ) over the known merits of Applicant's claims with regard to the reference to Musher (2,217,700) (1939). This includes, but is not limited to, "Reference V" sent by Examiner Jyoti Chwla to Applicant (Merriam Webster 3 pages, attached) where the PTO says a "composite material" is a "solid material" and the unit structure of Musher is anything but solid, (i.e. filled with interstices for ice cream) and,

As such, Applicant cannot properly respond to these allegations. Thus the finality of the Office Action is improper. (MPEP 706.07(a); MPEP 808.02. Accordingly, Applicant's amendments to the claims are therefore proper. Applicant is entitled to a means claim(s) section 112 (6) and method claims, below, unless proven otherwise by examiner. Examiner has not proven otherwise. Applicant therefore respectfully requests reconsideration and removal of the Final Office Action.

JAN-16-2009 07:04P FROM: DANIEL KIELY 9142456661

TO: 15712738300

P: 16/23

*Exhibit H Response to NFOA 1/16/09 page 1/2*Appn. Number 09/541,410 (Kiely)

GAU 1794

Amendment A

15

**Remarks - General**

Applicant submits that all claims clearly define novel and unobvious subject matter over each and every reference and any combination thereof.

**Amendments to Specification**

Examiner stated that the amendment filed July 30, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition of "composite material" in paragraphs [0043] [0044] and [0166], which was not disclosed in the specification as originally filed and has also been added to claims. The term "a composite material" as disclosed in the amendment would introduce new matter and change the description from "a candy bar" to "a composite material candy bar" in paragraph [0164] which is not the same as a generic term "candy bar" as originally described. Therefore, the amendments to the specification introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

See 608.01(i) **Original Claims** In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it.

Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.

In response, as said in previous responses to office actions, correcting the specification to reflect what is in the original claims, as filed, is NOT introduction of new matter.

Applicant's original disclosure August 18, 2000, illustrated and recited, "a composite material."

The mere mention that "composite material" changes the description from a "candy bar" to a

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"composite material candy bar" is not sufficient for a prima facie case of rejection under 35 USC 132(a), and is moot. Applicant's original claims 6, 19-23 recite: "wherein said support comprises a composite material." Drawings, the terms "composite support 62, 62A... Milky Way Bar, Snickers Bar, etc.," "composite candy bar" throughout the specification, and PTO date stamped disclosure documents 1994, 1996, 1999 showing and testing of composite material candy bars, is direct and factual evidence of a support comprising "a composite material." Examiner has failed to satisfy its burden to articulate a prima facie case. Without adequate evidence of the basis of this rejection, the burden to rebut this rejection with evidence and/or argument has not yet shifted to Applicant. Applicant has evidence in the original claims and in the specification. Examiner does not show sufficient evidence to the contrary.

N.B. Reading the specification shows a "composite material candy bar:"

[0195] A list of some suitable supports, are as follows:

[0196] composite candy bar with caramel, whipped chocolate nougat which is dipped in chocolate

[0197] composite candy bar with an elongated cookie stick, *with caramel on top of the caramel*, which is then dipped in chocolate

[0199] composite candy bar with chocolate, nuts and nougat inside

See MPEP section 2164. "Furthermore, when the subject matter is not in the specification portion of the application as filed but is in the claims, the limitation in and of itself may enable one skilled in the art to make and use the claim containing the limitation. When claimed subject matter is only presented in the claims and not in the specification portion of the application, *the specification should be objected to for lacking the requisite support for the claimed subject matter using Form Paragraph 7.44.* See MPEP § 2163.06. This is an objection to the specification only and enablement issues should be treated separately." 2163.06: "The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter."

Examiner thus admits that the terms "composite support 62," and "composite support 62A..." is interchangeable, or one in the same, for the term "composite material support 62, 62A..." or otherwise would have asked for a correction of the specification in the first office action in view of original claims 6, 19-23, and all the recitations of composite support 62 and "composite candy

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Regarding section 112, (first paragraph)  
apparatus or equipment is employed to make a support for a frozen confection as recited.

Claim 368 had already been corrected to recite: A support for a frozen comestible comprising a material comprising two edible ingredient materials, and means for making *said* support. Claim 369 is dependent upon claim 368 and is enabled. In addition, no disclosure of means or apparatus or equipment is required for a means claim. (35 U.S.C. 112, sixth paragraph)

Regarding the term composite material:

"The term "composite material" as added to the claims is objected to as introducing new matter as the term is not disclosed in the original disclosure and the introduction of the term "composite material" changes the description of "a candy bar" to "a composite material candy bar," which is not the same as a generic term "candy bar" as originally described. Therefore, the amendments to the claims introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

As above, in amendments to specification, the term "composite material" does not add new matter to the claims. The term "composite material" had been recited in original claims 6, 19-23. according to 608.01(i) Original Claims In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it and also consult MPEP section 2164. The original claims are part of the original disclosure and as such is not new matter. Also, the specification specifically recites *composite candy bar*, comprising two ingredient materials, as above. A bar that is a composite is a composite material to one skilled in the art. Applicant is not required to cancel the term "composite material" from the claims.

Regarding section 112 Second Paragraph

Examiner has rejected claims 349-359 as being unclear for the recitation of "comprising a material comprising two edible ingredient materials" as it is unclear as to what is encompassed by the terms "ingredient" and "material" and "ingredient material" as it is used in claim 349. Examiner states that it is unclear as to how each of the terms "ingredient" and material are different from

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Applicant. There is no requirement that patent applicant teach the meanings of every day widely used known terms, including the term "composite material."

Claim one of United States Patent 6,815,066 to Elliott (November 9, 2004) recites:

1. A composite comprising tungsten, tin and a polyfluorinated hydrocarbon

Since the USPTO issued patent to Elliott recites only "a composite" to reflect a composite material comprising tungsten, tin and a polyfluorinated hydrocarbon, one skilled in the art of making materials need not be apprised of any further explanation or any "specific definitions" of the term. "Composite" is well known enough to stand alone in the patent of Elliott, and is therefore well known enough to stand alone in the application above, as a material.

In addition, the term "composite material" is a well known term of commerce used in thousands of issued patents. There is no requirement for an applicant to teach the meaning, construction of, or method of a well known prior term actively used in commerce since at least since 1912:

Pearson's will be celebrating 90 years of St. Paul candy-making next month, and the popularity of its salty Nut Rolls, bodacious Nut Goodies, and signature Mint Patties shows no sign of abating.

"The first "composite" chocolate bar—featuring marshmallow, caramel, peanuts, and milk chocolate—was the Goo-Goo Cluster, which debuted just a few months before the Nut Goodie in 1912."

See: <http://www.citypages.com/1998-12-23/restaurants/the-ghost-of-candy-bars-past>  
December 1998 (composite chocolate bar, i.e. composite material chocolate bar "

#### Reference.com Background

The most primitive composite materials comprised straw and mud in the form of bricks for building construction; the Biblical book of Exodus speaks of the Israelites being oppressed by Pharaoh, by being forced to make bricks without straw being provided. The ancient brick-making process can still be seen on Egyptian tomb paintings in the Metropolitan Museum of Art

Examiner's argument that applicant's terminology "composite material." is "unclear," and the "subject matter is unclear and thus it renders the claims indefinite," "...unclear as to what is encompassed by said terms," lacks merit, and has lacked merit, and impeded prosecution for eight

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Exhibit K

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 76-81, 89, 90, 94 and 96 are rejected under 35 USC 112, first paragraph for being based on a non-enabling disclosure.

In regard to claim 76, claim 76 can be construed to recite that the edible support comprises one or more elements a through m, and particulate matter and a homogenous comestible. The claim is based on a non-enabling disclosure, since it is not seen that the specification supports one or more of elements a through m as well as having particulate matter and be homogenous. In fact, since the edible support is disclosed as being a composite, how can it be homogenous? The two are mutually inconsistent. Clarification and/or correction of the claim language is requested. That is, if the particulate matter and homogenous comestible are additional to the support, the claims, should reflect this. For purposes of examination, since applicant has not defined composite edible support, this phrase will be construed to mean any two materials in contact with each other. Claim 77 recites that the additional confection provides a "lollipop configuration". Neither claim nor the specification is clear as to what this means. Claim 79 recites that the supported comestible includes means for inhibiting the breakage of the edible support. As disclosed, it is not clear what is this "means for inhibiting breakage". Similarly in claim 80 for the phrase means for providing a supported comestible "designed for a child". How would this supported comestible differ from any other? What makes the comestible "designed for a child"? Claim 81 shares a

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support structure of Musher is non-frozen prior to addition of liquid and freezing steps. Thus the composite support for a frozen confection as taught by Musher is not-frozen until the ice cream material is poured into the voids and the entire structure is frozen

III) Applicant's arguments regarding the claimed invention

- a) Regarding the argument that "Musher's does not put voids in a support having two ingredient materials" (remarks, page 9) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. voids) are not recited in the rejected claim(s).
- b) Regarding the argument that "applicant's two ingredient materials need not be attached to each other", page 11, has been considered, however, it is noted that the features upon which applicant relies (i.e. "two ingredient materials need not be attached to each other") are not recited in the rejected claim(s).
- c) Regarding the argument that "Musher's support must be crisp", page 12, has been considered, however, it is noted that the features upon which applicant relies (i.e. "Musher's support must be crisp") are not relevant to the instantly claimed invention as it is not a limitation that is required as recited in the rejected claim(s).
- d) Regarding applicant's argument that "applicant's support provides surface area to first and second portions of a support" (Remarks, pages 9-12) it is noted that the features upon which applicant relies (i.e., applicant's support provides surface area to first and second portions of a support) are not recited in the rejected claim(s).
- e) Regarding applicant's argument that the "edible coating is placed between the two ingredient materials" (Pages 13-14) it is noted that currently rejected claims also do not recite the above statement.



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Thus the invention as recited in claims 53-78 are anticipated by Musher.

### **Response to Arguments**

Applicant's arguments filed 02/18/2010 have been fully considered but they are not persuasive.

On page 13 (last two paragraphs) of applicant's response (which is the first page of "Remarks" and has p.14 on top right of page corresponding to page number of FAX), applicant raises issues related to applications other than the one under examination and also that are not directly related to the examination of this application. As such, these issues will not be addressed in this office action.

On pages 14-17, applicant addresses issues related to claims that have been cancelled, and as such are now moot and issues related to pending claims will be addressed.

On page 18, applicants argue regarding the 35 USC 112, first paragraph rejection of the recitation "synergistic strength of sustaining stress against breakage". This argument is not persuasive. Applicant has focused on explaining the meaning of the words and quotes Para [0184] of specification in this context. The quoted part of specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, as it is not clear how much is the stress and hence it cannot be determine what is the strength required. Missing this information, it is not possible to be certain as to when this qualification is met and when it is not under different conditions.

On pages 19-21, applicant presents arguments about interpretation of the term "composite" and "composite material". On pages 21-26, applicant further presents arguments about the same issue. Examiner agrees with the definition

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of "a composite" provided from the dictionary in last paragraph of page 19. As the word "composite" is well understood (see applicant's arguments on page 21, 2<sup>nd</sup> last Para), it is reasonable to interpret per the provided standard definition, which is relevant to the context in which claims are presented in the specification, absent any special definition provided in the specification. Further, Musher teaches materials that are consistent with this definition. Musher teaches a method of making ice cream (frozen comestible) having an edible support structure that is an edible composite material (as it may be made of multiple materials like corn flakes, wheat flakes, bran flakes that are bound together by a binding agent; see Page 1: Column 1, lines 37-46; Page 2: Column 1, lines 1-10 and 33-43; Page 3: Column 2, lines 69-76; and Page 4: Column 1, lines 1-12). As such, applicant's assertion that "Examiner has not given any evidence of composite material" (see page 25, 7<sup>th</sup> last line) is not persuasive.

On page 22, lines 7-11, applicant alleges that "Examiner has failed to show any evidence of a non-frozen support". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a non-frozen support) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

On pages 22-23, applicant alleges that Musher does not show a "material that comprises two materials". However, examples given by applicant from Musher such as "flakes" or similar materials combined with "binder material", shows two materials. For further evidence of two or materials forming a composite material, applicant is referred to Musher (Page 1: Column 1, lines 37-46; Page 2: Column 1, lines 1-10 and 33-43; Page 3: Column 2, lines 69-76; and Page 4: Column 1, lines 1-12).

Exhibit M  
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(Kiely)

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Dictionary in last paragraph of page 19:

Merriam Webster Dictionary (reference V - 09/641,410) Definition: "a composite" (noun) as 4: a solid material which is composed of two or more substances having different physical characteristics and in which each substance retains its identity while contributing desirable properties to the whole; especially: a structural material made of plastic within which a fibrous material (as silicon carbide) is embedded.

Examiner also points out that Musher does not teach "a composite" by directing Applicant to read "page 3, col. 2, lines 69-76; and Page 4, column 1, lines 1-12, (page 6 of OA of 4/1/2010) which includes:

"...Thereupon after congelation and hardening-ing of these materials, the liquid ice cream mix, for instance is filled into the openings and spaces of the structure..."

and further directs Applicant to view all six drawings:

"The support as taught by Musher (figures 1-6)..." (page 6 of OA of 4/1/2010).

In response, all six figures show that the unit structure of Musher requires openings and spaces, and is in fact not solid. (emphasis added).

Examiner further instructs Applicant that Musher teaches: "(Page 1, column 1 to Page 5, column 2, line 40; Page 5 which includes:

"In other words, in the making of an ice cream confection, for instance, it is it is expected that the ice cream should be the predominant flavor element and that it should be the base material. In view of this it is therefore desired that the unit structure of this invention should be of a form so as to permit the storage or retention within its own structure form.

Exhibit N

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|                                   |                                       |                                                                        |             |
|-----------------------------------|---------------------------------------|------------------------------------------------------------------------|-------------|
| <b>Notice of References Cited</b> | Application/Control No.<br>09/641,410 | Applicant(s)/Patent Under<br>Reexamination<br>O'DONNELL-KIELY, ALICE M |             |
|                                   | Examiner<br>JYOTI CHAWLA              | Art Unit<br>1794                                                       | Page 1 of 1 |

## U.S. PATENT DOCUMENTS

| * |   | Document Number<br>Country Code-Number-Kind Code | Date<br>MM-YYYY | Name               | Classification |
|---|---|--------------------------------------------------|-----------------|--------------------|----------------|
| * | A | US-1,690,984                                     | 11-1923         | LANE FRED W et al. | 426/94         |
|   | B | US-                                              |                 |                    |                |
|   | C | US-                                              |                 |                    |                |
|   | D | US-                                              |                 |                    |                |
|   | E | US-                                              |                 |                    |                |
|   | F | US-                                              |                 |                    |                |
|   | G | US-                                              |                 |                    |                |
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|   | J | US-                                              |                 |                    |                |
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## NON-PATENT DOCUMENTS

| * |   | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
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\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
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Notice of References Cited

Part of Paper No. 20090622